REMARKS

Foreign Priority

The acknowledgement, in the Office Action, of a claim for foreign priority under 35 U.S.C. § 119(a)-(d), and that the certified copy of the priority document has been received, is noted with appreciation.

Status Of Application

Claims 42-67 are pending in the application; the status of the claims is as follows:

Claims 42-49 and 56-67 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,738,491 B1 to Ikenoue et al. (the '491 patent) in view of U.S. Patent No. 5,363,202 to Udagawa et al ("Udagawa").

Claims 42, 46, 56, 59, 62, and 65 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15 and 17 of U.S. Patent No. 5,671,277 (the '277 patent) to Ikenoue et al in view of Udagawa.

Claims 42, 46, 56, 59, 62, and 65 are also rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15 and 17 of the '277 patent.

Double Patenting Rejection

The provisional rejection of claims 42-49 and 56-67 under the judicially created doctrine of double patenting over claims 1-26 of the '491 patent in view of Udagawa, is respectfully traversed based on the following.

Udagawa shows an image forming apparatus connected to a communication line via a bus selector 1106 (Figure 13). The bus selector selects between three modes: 1)

image scanner; 2) image scanner – communication line (facsimile transmission mode); and 3) communication line – printer (facsimile receiving mode) (col. 12, lines 27-34). There is no suggestion in Udagawa that the communication line be used for anything other than facsimile images. In addition, there is no mention of copyright information.

Claim 1 of the '491 reads:

> 1. An image forming apparatus comprising:
> an input device for inputting image data;
> an extracting device for extracting additional data embedded in input image data; and
> an analyzer for analyzing a distribution path from original image data, which corresponds to such input image data, to the input image data by said input device based on that additional data extracted by said extracting device.

In contrast to the cited references, claim 42 includes:

> an extractor for extracting additional data embedded in said image data input by the input device, said additional data including information in connection with a *copyright* of said inputted image data; (*Italics added*)

Neither the claims of the '491 patent nor Udagawa provide any suggestion related to copyright information. The obviousness determination in obviousness-type double patenting "parallels the guidelines for analysis of a 35 U.S.C. § 103 obviousness determination." MPEP §804(II)(B)(1). To support a *prima facie* case for obviousness, the cited references must show or suggest every limitation of the claim. MPEP §2143.03. Because there is no suggestion relating to copyright information in the claims of the '491 or Udagawa, the cited references do not show or suggest every limitation of the claims and thus do not support a *prima facie* determination of obviousness. Therefore, a rejection of claim 42 under the judicially created doctrine of double patenting based in the cited references is not supported by those references. Claims 43-45 are dependent upon claim 42 and thus include every limitation of claim 42. Therefore, the cited references

also do not support a rejection of claims 43-45 under the judicially created doctrine of double patenting.

Also in contrast to the cited references, claim 46 includes:

> extracting the additional data embedded in the input image data, wherein said additional data includes information in connection with a copyright of the image data

As noted above, neither the claims of the '491 patent nor Udagawa provide any suggestion related to copyright information. Because there is no showing or suggestion relating to copyright information in the claims of the '491 or Udagawa, the cited references do not support a *prima facie* determination of obviousness of claim 46. Claims 47-49 are dependent upon claim 46 and thus include every limitation of claim 46. Therefore, the cited references also do not support a rejection of claims 47-49 under the judicially created doctrine of double patenting.

Also in contrast to the cited references, claim 56 includes:

> communication means for communicating with said plurality of image processing devices via a communication line to receive additional data that includes information that corresponds to a copyright of the image data

As noted above, neither the claims of the '491 patent nor Udagawa provide any suggestion related to copyright information. Because there is no showing or suggestion relating to copyright information in the claims of the '491 or Udagawa, the cited references do not support a *prima facie* determination of obviousness of claim 56. Claims 57-61 are dependent upon claim 56 and thus include every limitation of claim 56. Therefore, the cited references also do not support a rejection of claims 57-61 under the judicially created doctrine of double patenting.

Also in contrast to the cited references, Claim 62 includes:

> an extractor for extracting additional data embedded in said input image data, said additional data including information corresponding to a copyright of said input image data;

As noted above, neither the claims of the '491 patent nor Udagawa provide any suggestion related to copyright information. Because there is no showing or suggestion relating to copyright information in the claims of the '491 or Udagawa, the cited references do not support a *prima facie* determination of obviousness of claim 62. Claims 63-67 are dependent upon claim 62 and thus include every limitation of claim 62. Therefore, the cited references also do not support a rejection of claims 63-67 under the judicially created doctrine of double patenting.

Accordingly, the provisional rejection of claims 42-49 and 56-67 under the judicially created doctrine of double patenting over claims 1-26 of patent '491 in view of Udagawa, be reconsidered and withdrawn.

The provisional rejection of claims 42, 46, 56, 59, 62, and 65 under the judicially created doctrine of double patenting over claims 15 and 17 of patent '277 in view of Udagawa, is respectfully traversed based on the following.

Claims 15 and 17 of the '277 patent state:

> 15. An image forming apparatus comprising:
> a memory which stores image data comprising data of a document and additional data embedded in the image data of the document;
> an image forming device which forms an image on a paper according to said image data and said additional data; and
> an extraction device which extracts said additional data from said image data,
> wherein said additional data comprises a plurality of pixels having a density different from pixels of said image data and embedded in said image data in a prescribed format to indicate information by distances between pixels of said plurality of additional data pixels,

wherein said additional data further includes data which indicates a starting position of said additional data embedded in said image data.

17. The image forming apparatus according to claim 15, further comprising an analysis device which analyzes image data received from a computer or from a floppy disk drive to be stored in said memory, wherein the image data stored by said memory comprises the image data received from said analysis device.

As with Udagawa and the claims of the '491 patent, claims 15 and 17 of the '271 patent provide no showing or suggestion related to copyright information. As noted in the quoted portions of each claim above, each of claims 42, 56 and 62 include a limitation that the additional data includes copyright information. Therefore, the cited references do not support a rejection of claims 42, 56 and 62 under the judicially created doctrine of double patenting. Claims 46, 59 and 65 are dependent upon claims 42, 56 and 62, respectively, and thus include every limitation of those claims. Therefore, the cited references also do not support a rejection of claims 46, 59 and 65 under the judicially created doctrine of double patenting.

Accordingly, the provisional rejection of claims 42, 46, 56, 59, 62, and 65 under the judicially created doctrine of double patenting over claims 15 and 17 of patent '277 in view of Udagawa, be reconsidered and withdrawn.

The provisional rejection of claims 42, 46, 56, 59, 62, and 65 under the judicially created doctrine of double patenting as being unpatentable over claims 15 and 17 of patent '277, is respectfully traversed based on the following.

As noted above, claims 15 and 17 of the '271 patent provide no showing or suggestion related to copyright information. Also, as noted in the quoted portion of each claim above, each of claims 42, 56 and 62 include a limitation that the additional data includes copyright information. Therefore, the cited references do not support a rejection of claims 42, 56 and 62 under the judicially created doctrine of double patenting. Claims 46, 59 and 65 are dependent upon claims 42, 56 and 62, respectively, and thus

include every limitation of those claims. Therefore, the cited references also do not support a rejection of claims 46, 59 and 65 under the judicially created doctrine of double patenting.

Accordingly, the provisional rejection of claims 42, 46, 56, 59, 62, and 65 under the judicially created doctrine of double patenting as being unpatentable over claims 15 and 17 of patent '277, be reconsidered and withdrawn.

CONCLUSION

Wherefore, in view of the foregoing remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

Any fee required by this document other than the issue fee, and not submitted herewith should be charged to Sidley Austin LLP Deposit Account No. 18-1260. Any refund should be credited to the same account.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee,

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Respectfully submitted,

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